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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/603,764	06/22/2000	Roy Martin	1519.016	2537

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Peter C. Lando
c/o Wolf, Greenfield & Sacks, P.C.
Federal Reserve Plaza
600 Atlantic Avenue
Boston, MA 02210-2211

EXAMINER

ANTHONY, JOSEPH DAVID

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 12/12/2001

6

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/603,764

Applicant(s)

Examiner

Group Art Unit

1714

☒ Responsive to communication(s) filed on 10/9/01 & 11/30/01

☐ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-9 is/are pending in the application.

Of the above, claim(s) 7-9 is/are withdrawn from consideration.

☐ Claim(s) is/are allowed.

☒ Claim(s) 1-6 is/are rejected.

☐ Claim(s) is/are objected to.

☐ Claims are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.

☐ received in Application No. (Series Code/Serial Number)

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received:

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s) 5

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-6, drawn to methods for inhibition of corrosion of metal, classified in class 252, subclass 387.
 - II. Claims 7-9, drawn to a method of inhibition corrosion during removal of deposits from a metal, classified in class 252, subclass 80.
2. The inventions are distinct from each other because they are drawn to two different methods wherein Group I claims do not require the step of removing deposits from a metal during the method of inhibiting corrosion of the metal as required by Group II claims.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
4. Because these inventions are distinct for the reasons given above and the search required for Group II is not required for Group I, restriction for examination purposes as indicated is proper.
5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

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6. During a telephone conversation with Peter C. Lando on 12/10/01 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-6. Affirmation of this election must be made by applicant in replying to this Office action. Claims 7-9 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 2-3, and 5 and rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 2-3 and 5 all use improper markush claim language in that the word "or" needs to be replaced by the word --and-- at the end of the markush groups.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

10. Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by Zinkan et al. U.S. Patent Number 5,382,367 and Coughlin et al. U.S. Patent Number 5,800,732.

Zinkan et al teaches a method of treating cooling water system to prevent and control the corrosion and buildup of scales in said systems. The method comprises using low concentrations of hydrogen peroxide, see the abstract. Applicant's claims are deemed to be anticipated over Example III and Table I.

Coughlin et al teaches a concentrated all-in-one treatment compositions for cooling water systems. The compositions contain high concentrations of peroxide (such as hydrogen peroxide, alkali metal peroxides, organic peroxides (e.g. peracetic acid)), peroxide stabilizer (such as a phosphonate), polyhydric alcohol, and optional additional metal corrosion inhibitors, see the abstract, and column 1, lines 55-67. Applicant's claims are deemed to be anticipated over Example 2 wherein the all-in-one treatment is added to the water in a cooling tower such that the peroxide is in very low concentration.

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11. Claims 1-2 are rejected under 35 U.S.C. 102(b) as being anticipated by Ono U.S. Patent Number 5,736,097.

Ono teaches method of preventing pitting corrosion of copper or copper alloy water systems by the addition of low concentrations of peroxides (e.g hydrogen peroxide, peroxocarbonates, peroxyacetates etc.), see the abstract and column 2, lines 7-47. Applicant's claims are deemed to be anticipated over the examples.

12. Claims 4-6 are rejected under 35 U.S.C. 102(b) as being anticipated by LaZonby et al U.S. Patent Number 5,658,467.

LaZonby et al teaches method and compositions for inhibiting growth of microorganisms by the adding sufficient amounts of peracetic acid and a non-oxidizing biocide to industrial process waters systems. Applicant's claims are deemed to be anticipated over Example 7.

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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14. Claims 4-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Coughlin et al. U.S. Patent Number 5,800,732 and Ono U.S. Patent Number 5,736,097.

Coughlin et al and Ono have been described above. Coughlin et al and Ono both differ from applicant's claimed invention in that there is no direct teaching (i.e. by way of an example) to where a peroxycarboxylic acid is used in leu of hydrogen peroxide.

It would have been obvious one having ordinary skill in the art to use the disclosure of Coughlin et al at column 1, lines 63-67, and Ono at column 2, lines 14-19, as motivation to actually use a peroxycarboxylic acid in leu of hydrogen peroxide in their treatment of cooling water systems.

15. Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Woyciesjes U.S. Patent Number 5,000,866 and Hirozawa et al. U.S. Patent Number 4,234,440.

Woyciesjes and Hirozawa et al both teaches antifreeze compositions that are buffered with electrolytes wherein said buffered compositions inhibit the corrosion of metals that they come in contact with. Both references further disclose that optional known anti-corrosion agents may be added to their antifreeze compositions, see the abstract, examples, and claims of both patents. Furthermore see, column 4, lines 3-25 of Hirozawa et al and column 10, lines 39-40 of Woyciesjes.

Woyciesjes and Hirozawa et al both differ from applicant's claimed invention in that they do not directly teach (i.e. by way of an example) the further addition of hydrogen peroxide as an

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additional anti-corrosion agent to their anti-freeze compositions. It would have been obvious to one having ordinary skill in the art to use the broad disclosure of Woyciesjes and Hirozawa et al as motivation to actually add hydrogen peroxide as an additional metal anti-corrosion inhibitor, since both references individual directly disclose the hydrogen peroxide is known in the art to be an effective corrosion inhibitor, see column 1, lines 15-39 of Woyciesjes and column 1, lines 40-57 of Hirozawa et al..

Information Disclosure Statement

16 The information disclosure statement filed 11/30/01 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each U.S. and foreign patent; each publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

17 The information disclosure statement filed 11/30/01 also fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. It has been placed in the application file, but the information referred to therein has not been considered.

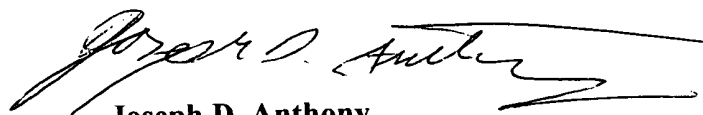
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Prior-Art Cited But Not Applied

18. Any prior-art reference which is cited on FORM PTO-892 but not applied, is cited only to show the general state of the prior-art at the time of applicant's invention.

Examiner Information

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Joseph D. Anthony whose telephone number is (703) 308-0446. This examiner can normally be reached on Monday through Thursday from 7:35 a.m. to 6:00 p.m. in the eastern time zone. If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on (703) 306-2777. The group FAX machine number is (703) 305-5408. The group FAX machine numbers are (703) 305-5408, (703) 305-7718, and (703) 305-5433. Unofficial correspondence transmitted by FAX must be marked "DRAFT". All other papers received by FAX will be treated as Official communications and cannot be immediately handled by the Examiner. Any inquiry of a general nature or relating to the status of this application should be directed to the receptionist whose telephone number is (703) 308-0651. The receptionist is located on the 8th floor of Crystal Plaza 3 (e.g. CP-3) and will be the welcome point for all visitors to the building.



**Joseph D. Anthony
Primary Patent Examiner
Art Unit 1714**

12/14/01